

**IN THE HIGH COURT AT CALCUTTA
ORDINARY ORIGINAL CIVIL JURISDICTION
ORIGINAL SIDE
[Commercial Division]**

BEFORE:

The Hon'ble Justice Ravi Krishan Kapur

IA NO. GA/1/2022
In CS/269/2022

FOX & MANDAL AND ORS.
Vs
SOMABRATA MANDAL AND ORS.

For the petitioners	: Mr. S. N. Mookherjee, Senior Advocate Mr. Ratnanko Banerjee, Senior Advocate Mr. Soumya Roychowdhury, Advocate Mr. Souvik Chowdhury, Advocate Mr. Paritosh Sinha, Advocate Mr. Tirthankar Das, Advocate
For the respondent no.1	: Mr. Krishnaraj Thakkar, Advocate Ms. Mamta Tiwari, Advocate Mr. Partha Ghosh, Advocate Mr. Ajay Chaubey, Advocate Mr. Savinder Singh, Advocate Mr. Biswarup Mukherjee, Advocate Mr. Debmalya Ghosal, Advocate Dr. Ms. Kreeti Gupta, Advocate Ms. Saudamini Sharma, Advocate Mr. Soumya Paul, Advocate Mr. Vinayak Chaubey, Advocate
For the proforma respondent no.3	: Mr. Joy Saha, Senior Advocate Mr. Soumabho Ghosh, Advocate Mr. Sarvapriya Mukherjee, Advocate Mr. D. Sarkar, Advocate
For the proforma respondent no.4	: Mr. J. Chowdhury, Advocate Mr. B. Kumar, Advocate
Reserved on	: 08.05.2023
Judgment on	: 27.09.2023

Ravi Krishan Kapur J.:-

1. This is a suit inter-alia for passing off.
2. The petitioner no.1 is a registered partnership firm engaged in providing legal and other similar services. The petitioner no.1 was incorporated in 1896 and has since been using the mark "Fox & Mandal". The petitioner no.2 is a limited liability partnership. The words "Fox & Mandal" also form the business name of the firm. The petitioner nos.1 and 2 enjoy immense goodwill both in the legal and business fraternity.
3. Originally, the firm began as a partnership between John Kerr Fox, an English attorney and Gokul Chandra Mandal, an Indian attorney. There is ample evidence to demonstrate that the firm had been carrying on business operations since 1896. Due to the passage of time and the death of the partners, the firm has been reconstituted on several occasions.
4. The firm is also the owner of the trademark "Fox & Mandal" which had been registered on 7th March, 2006 in Class 42 with the user date of the mark recorded as since 1st January, 1896. The firm is also the proprietor of a number of other registered marks.
5. The respondent no.2 is a partnership firm which was registered in the year 1984 by the then partners of the petitioner no.1 having its principal place of business at Delhi. In 2003, the respondent no.1 had also caused a trademark to be registered in his name. The registration certificate in

favour of the respondent no.1 records the user details of the respondent no.2, since 31st December, 1986.

6. The respondent no.1 is the eldest son of the Late Dinabandhu Mandal who was one of the common partners of the petitioner no.1 and the respondent no.2. Admittedly, the respondent no.1 had never been a partner of the petitioner no.1. He and his wife have always been associated with the respondent no.2.
7. The disputes between the parties culminating in the filing of this suit have arisen after the death of Dinabandhu Mandal on 30th June, 2022. The petitioner no.3 and the proforma no.3 had on 2nd October, 2001 resigned from the respondent no.2. Thus, since the death of the Late Dinabandhu Mandal, the petitioner no.1 and the respondent no.2 have had no common partners at all.
8. It is submitted that the respondent nos.1 and 2 are seeking to pass off their business as that of the petitioner no.1 and claim to have a legacy of 125 years. Significantly, the respondent no.1 had only become a partner of the respondent no.2 in the year 1996 and the respondent no.2 was established only in the year 1986. In such circumstances, any representation that the respondent nos.1 and 2 had been incorporated in the year 1896 and claims to be India's oldest and largest law firm and thereby associated with the petitioner no.1 is false and an attempt to encash on the goodwill and reputation of the petitioner no.1.

9. The petitioners are also aggrieved with a number of publications in various newspapers and other online portals published on 15th October 2022, whereby the respondent nos.1 and 2 have been described as being India's oldest law firm since 1896. The petitioners contend that on a reading of the reconstituted partnership deed, the respondent no.1 as one of the legal heirs of the Late Dinabandhu Mondal is only entitled to a monetary claim in respect of the goodwill of the petitioner no.1. In support of their contentions, reliance is placed on *Bhagwan Dass Khanna Jewellers versus Bhagwan Das Khanna Jewellers Private Limited and Others* (2012) SCC OnLine Del 6129, *Byford vs. Oliver & Anr.* [2003] All ER(D) 345, *S. Syed Mohideen vs. P. Sulochana Bai* (2016) 2 SCC 683, *M/s. Power Control Appliances & Ors. vs. V. Sumeet Machines Pvt. Ltd.* (1994) 2 SCC 448, *Singh & Singh Law Firm LLP vs. Singh + Singh Lawyers LLP* 2021 SCC OnLine Del 3059, *S.K. Sachdeva & Anr. vs. Shri Educare Limited & Anr.* (2016) 65 PTC 614, *Kirloskar Diesel Recon Pvt. Ltd. vs. Kirloskar Proprietary Limited*, AIR 1996 Bom 149.
10. On behalf of the respondent nos.1 and 2 it is contended that, the petitioner no.1 does not have the right of exclusive ownership in the marks "Fox & Mandal", "Fox and Mandal" or "F & M". The marks "Fox & Mandal" "Fox and Mandal" or "F & M" are family marks and belong to the Mandal family at least since the demise of Mr. J. K. Fox. The share of Late Dinabandhu Mandal in the goodwill of the petitioner no.1 firm has also devolved on the respondent no.1. The goodwill in the mark of the

petitioner no.1 firm is a shared or common goodwill and the respondent no.1 has contributed to the same. There has also been acquiescence by the petitioners and they are now estopped from contending otherwise. In support of their contentions, the respondents rely on *Shri Ram Education Trust Vs. SRF Foundation & Anr.* 2016 SCC OnLine Del 472, *Khushal Khemgar Shah & Ors. Vs. Mrs. Khorshed Banu Dadiba Boatwlla & Anr.* (1970) 1 SCC 415, *Rajni Dua & Ors. vs. Bhushan Kumar & Ors.* 1998 SCC OnLine Del 620, *Krishna Sweets Pvt. Ltd. vs. M. Murali* 2017 SCC OnLine Mad 4405, *Habib Bank Ltd. vs. Habib Bank A.G. Zurich* [1980] EWCA Civ J1218-2, *Lancer Trade Mark* (1987) RPC 303, *HFC Bank Plc vs. Midland Bank Plc* [2000] F.S.R. 176, *Dalip Singh vs. State of UP* (2010) 2 SCC 114.

11. The petitioner no.1 was incorporated in the year 1896 and has since been continuously, uninterruptedly and extensively using the mark "Fox & Mandal". The respondent no.1 has never been a partner of the petitioner no.1. The father of the respondent no.1 died on 30th June, 2020 and on his death he ceased to be a partner of the petitioner no.1. There are disputes inter se between the sons of the Late Dinabandhu Mandal pertaining to his estate. The youngest son of Late Dinabandhu Mandal who was the sole surviving partner in the petitioner no.1 has amicably resolved all disputes between himself and the petitioner no.1. Thereafter, the petitioner no.1 had been reconstituted on 30th March, 2022. A suit filed by the petitioner no.1 being CS 178 of 2022 (*Fox and Mondal Co. vs. Somabrata Mondal*) is also pending before this Court in

respect of the share of Late Dinabandhu Mandal in the petitioner no.1 partnership business. It is also an incontrovertible fact that the petitioner no.1 is the prior user and first in the market of the mark “Fox & Mandal”. This assumes significance in an action for passing off which is for protection of the rights of the prior user who has created the goodwill in the market. The petitioner no.1 firm is the only source and origin of any goodwill in the marks “Fox & Mandal”, “Fox and Mandal” and “F & M”. The case of registration of an associated mark has no relevance in an action for passing off [S. *Syed Mohideen vs P. Sulochana Bai* (2016)2 SCC 683 at paras 30.4 and 31.2, *M/s. Power Control Appliances & Ors. vs V. Sumeet Machines Pvt. Ltd.* (1994) 2 SCC 448 at para 41].

12. Sections 14 and 55 of the Indian Partnership Act, 1932 provide as follows:

14. The property of the firm.—Subject to contract between the partners, the property of the firm includes all property and rights and interests in property originally brought into the stock of the firm, or acquired, by purchase or otherwise, by or for the firm, or for the purposes and in the course of business of the firm, and includes also the goodwill of the business. Unless the contrary intention appears, property and rights and interests in property acquired with money belonging to the firm are deemed to have been acquired for the firm.

55. Sale of goodwill after dissolution.- (1) In settling the accounts of a firm after dissolution, the goodwill shall, subject to contract between the partners, be included in the assets, and it may be sold either separately or along with other property of the firm.

Rights of buyer and seller of goodwill.-(2) Where the goodwill of a firm is sold after dissolution, a partner may carry on a business competing with that of the buyer and he may advertise such business, but, subject to agreement between him and the buyer, he may not,-

(a) use the firm name,

(b) represent himself as carrying on the business of the firm, or

(c) solicit the custom of persons who were dealing with the firm before its dissolution.

Clause 17 of the reconstituted partnership deed dated 27 October, 2014 is set out below:

“17. The death or retirement of a partner shall not dissolve the partnership but the partnership shall be carried on by the surviving partners. The partnership accounts shall be made up after two years from the date of death/retirement of a partner but within three years from the said date. The share of the deceased or retiring partner in the outstanding bills upto the date of his death/retirement less the cost of realization assessed at 30% of the amount realized on these bills shall be paid to the retiring partner or the legal representative of the deceased partner on account of his share of the profit and goodwill of the firm. The amount payable for the share of profit and goodwill of the deceased/retiring partner to be calculated in the manner aforesaid shall be determined and paid in the manner decided by Dinabandhu Mandal in his absolute discretion and the heirs of the deceased partner or the retiring partner shall not be entitled to raise any question or objection thereto.”

13. Any goodwill generated by a partnership is a partnership asset. All the partners have an interest in the assets of the partnership but that does not mean that they own the assets themselves [*Byford vs. Oliver & Anr. (2003) All ER (D) 345*]. There is also no question of claiming any legacy to

a partnership asset which exclusively belongs to the firm. The disputes in respect of the surviving rights of the estate of the Late Dinabandhu Mandal are the subject matter of a pending suit being CS 178 of 2022 filed before this Court. In any event, *prima facie* the only entitlement of the respondent no.1 as heir of Late Dinabandhu Mandal is in monetary compensation and nothing further. This cannot by any stretch of imagination entitle the respondent nos.1 and 2 to any right over the use of the business name or marks of the petitioner no.1 or to be permitted to represent to the public of having any association or connection with the services being rendered by the petitioner no.1. The respondent no.1 is not entitled to use any mark belonging to the petitioner no.1 either as grandson of Late Sudhir Kumar Mandal or as the son of the Late Dinabandhu Mandal. Any such third party right in favour of the respondent no.1 would amount to an entitlement which is neither justified nor warranted.

14. The petitioners primary grievance pertain to the impugned articles and publications describing the respondent no.1 to be associated with the petitioner no1. Insofar as the impugned articles and publications describe the respondent no.1 to be synonymous with the petitioner no.1 firm, the same are ex facie false and misleading. Any suggestion that there exists any connection or association between the petitioner no.1 and the respondent nos.1 and 2 is confusing. Misrepresentation lies in the heart of a passing off action (*Kerly's Law of Trademark and Trade Names*,

16th Ed, 20-026). Any confusion is bound to be damaging and have undesirable ramifications in diluting the goodwill of the petitioner no.1 (*Singh & Singh Law Firm LLP vs. Singh + Singh Lawyers LLP 2021 SCC OnLine Del 3059*). The respondent nos.1 or 2 cannot claim to have a legacy of 125 years and thereby trade or encash on the goodwill and reputation of the petitioner no.1. The impugned articles and publications cannot be described as sheer coincidence. Undoubtedly, the impugned publications create an association of sorts in the public mind between the respondent nos.1 and 2 and the petitioner no.1 and therein lies the confusion and misrepresentation. This is crucial in an action for passing off.

15. There is also no merit in the contention that the marks "Fox and Mandal", "Fox & Mandal" or "F & M" are family marks. This argument is unsubstantiated. The name of the petitioner no.1 ex facie demonstrates that the partners of the petitioner no.1 were not exclusively members of the Mandal family. The original partner of the firm John Kerr Fox was not a member of the Mandal family. In any event, there is no reason why the sons bearing the surname Mandal should only be entitled to any right in the alleged family mark. If this argument were to succeed then all the heirs of Gokul Chand Mandal would be entitled to a right in such marks. The actions of the respondent no.1 being exclusively associated with the respondent no.2, not being a partner of the petitioner no.1 and causing an independent mark to be registered in his name also negates

against the argument of family mark or shared reputation. There is also no right which the respondent no.2 can claim either by way of common lineage or family mark or shared goodwill in respect to the marks belonging to the firm. Any prior association of the respondent no.1 with the petitioner no.1 firm cannot extend to a right to use the marks or the business name of the petitioner no.1. [*S.K. Sachdeva & Anr. vs. Shri Educare Limited & Anr. (2016) 65 PTC 614, Kirloskar Diesel Recon Pvt. Ltd. vs. Kirloskar Proprietary Limited, AIR 1996 Bom 149*].

16. There is no quarrel with the proposition laid down in the cases cited by the respondents. In *Anderson & Lembke Limited v. Anderson & Lembke Inc. (1998) RPC 124*, it was held that there was no misrepresentation. In *Khushal Khemgar Shah (Supra)* the concept and consequences of dissolution have been laid down. It is true that the goodwill of a firm cannot be ignored upon the death of a partner. However, in view of Clause 17 of the partnership deed, the only entitlement of respondent no.1 is in monetary consideration. In any event, this issue is the subject matter of a pending suit. The facts of *Shri Ram Education Trust Vs. SRF Foundation & Anr. (Supra)* are also distinguishable. In the said decision, the parties were claiming a right to a common family lineage shared between the parties. The plaintiffs were also found not to be prior users of the name Shri Ram for educational institutions. Moreover, not only were other members of the family using the impugned mark but third parties had also adopted the said mark for educational institutions prior

to the plaintiffs. In conclusion, the defendants were inter alia directed to show that they have no connection or relation with the plaintiffs' school. Similarly, in the decision *HFC Bank Plc vs. Midland Bank Plc* (Supra), the plaintiff was unable to establish any goodwill. In *Lancer Trade Mark* (Supra), the Court held that there was no likelihood of confusion between the two marks. The decisions in *Rajni Dua & Ors vs Bhushan Kumar & Ors* 1998 SCC Online Del 620 and *Krishna Sweets Pvt Ltd vs M. Murali* 2017 SCC Online Mad 4405 are also distinguishable and inapposite. There is no dispute insofar as interpretation of family settlements or arrangements are concerned. However, in view of clause 17 and the legal rights of the parties, both the said decisions are inapplicable.

17. There is also no substance in the defence of acquiescence. *Prima facie*, there is no conduct of the petitioners inconsistent with the claim for exclusivity in the marks of the petitioner no.1. In order for such defence to succeed, there must be a positive act by the petitioners not mere silence or inaction [*M/s. Power Control Appliances & Ors. vs. V. Sumeet Machines Pvt. Ltd. (1994) 2 SCC 448* at para 26]. The decision in *Habib Bank Ltd. vs. Habib Bank A.G. Zurich* (Supra) is inapposite. In this case, it was found that both the entities had been set up by the same parent company and their staff were also freely interchangeable.

18. Upon the filing of the suit, by an order dated 4th November, 2022 it was directed that there would be no further publications similar to those published in page 574 to 592 of the petition. Thereafter, by a further

order dated 15th November, 2022 the respondent nos.1 and 2 were directed not use the marks “Fox and Mandal” or “F & M” till the final hearing of this application. The orders at the ad interim stage were assailed in an appeal. By an order dated 16th December, 2022 the Hon’ble Division Bench refused to interfere with any of the ad interim orders. Thereafter, by an order dated 10 February, 2023 the Special Leave Petition filed against the order dated 16 December, 2022 was also dismissed as withdrawn. Diverse orders have also been passed in an attempt to settle the disputes between the parties. However, both parties were unable to arrive at any settlement. Attempts to mediate between the parties had also failed.

19. For the abovementioned reasons, the petitioners have been able to demonstrate a strong prima facie case on merits. The balance of inconvenience and irreparable injury is also in favour of protective orders being passed. Accordingly, the ad-interim orders dated 4 November, 2022 and 15 November, 2022 stand confirmed. The respondent nos.1 and 2, their men, servants, agents and assigns and other partners are restrained from holding themselves out in any manner whatsoever of being associated with the petitioner no.1 or the petitioner no.2 or claiming a legacy in the year of establishment of the petitioner no.1 i.e. 1896 or passing off their firm or their legal services as that of the petitioner no.1 or the petitioner no.2 and also from using the marks “Fox and Mandal”, “Fox & Mandal or F & M”. All other issues including the

question of restraint on the use of the marks “Fox Mandal”, “Fox Mandal & Co.” or “FM” or any other deceptively similar mark and the question of disclaimer on either of the marks are left to be adjudicated upon at the time of trial.

20. With the aforesaid directions, GA 1 of 2022 stands disposed of.

(Ravi Krishan Kapur J.)